

Office Action Summary

Application No.

08/997,706

Applicant(s)

Ejiri, Seishi

Examiner

Joseph Pokrzywa

Group Art Unit

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☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:
step "S29" in Fig. 4; and
step "S66" and step "S70" in Fig. 10.

Correction is required.

Specification

3. The disclosure is objected to because of the following informalities:
on page 7, line 25, "(step S8)" should be inserted after "interface 117";
on page 18, line 1, "(step S65)" should be inserted after "transferred".

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1 through 16, and 18 through 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 1 and 7**, the word "means" is preceded by the word(s) "connection" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

6. **Claim 13** recites the limitations "the reception step" in line 5, "the designation step" in line 8, and "the storage step" in line 10. There is insufficient antecedent basis for these limitations in the claim.

7. **Claim 18** recites the limitations "the input step" in line 5, "the transmission step" in line 7, and "the notification step" in line 9. There is insufficient antecedent basis for these limitations in the claim.

8. **Claim 19** recites the limitations "the input step" in line 5, "the designation step" in line 7, "the transmission step" in line 8, and "the notification step" in line 10. There is insufficient antecedent basis for these limitations in the claim.

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9. **Claim 20** recites the limitations "the reception step" in line 7, "the designation step" in line 10, and "the storage step" in line 12. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. **Claims 1, 7, 18, and 19** are rejected under 35 U.S.C. 102(b) as being anticipated by Okumura *et al.* (U.S. Patent Number 5,293,250).

Regarding **claim 1**, Okumura discloses a data communication system (electronic mailing system) which comprises a means connected to a data processing terminal (PBX 140 connected to mail terminal 161 in Figs. 1 and 11, and column 6, lines 40 through 47), a means for inputting a manual designation caused by an operator (mail terminal 161, and column 3, line 66 through column 4, line 34), a means for transmitting data on the basis of the designation input by the operation means (column 4, lines 48 through 62), and a means for notifying information related to data transmission performed by the transmission means based on the designation input by the

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operation means to the data processing terminal through the connection means in accordance with a change in state of the data communication system (column 4, lines 35 through 47).

Regarding **claim 7**, Okumura discloses a data communication system (electronic mailing system) which comprises a means connected to a data processing terminal (PBX 140 connected to mail terminal 161 in Figs. 1 and 11, and column 6, lines 40 through 47), a means for inputting a manual designation caused by an operator (mail terminal 161, and column 3, line 66 through column 4, line 34), a means for designating an ID by an operation of the operation means (column 3, line 68 through column 4, line 2, and lines 50 through 62, and column 7, lines 9 through 22), a means for transmitting data on the basis of the designation input by the operation means (column 4, lines 48 through 62), and a means for notifying information related to data transmission performed by the transmission means based on the designation input by the operation means to the data processing terminal through the connection means in accordance with the ID designation performed by the designation means (column 4, lines 35 through 47).

Regarding **claim 18**, Okumura discloses a computer readable program (column 3, lines 56 through 68) stored in a storage medium for controlling a data communication system connected to a data processing terminal (PBX 140 connected to mail terminal 161 in Figs. 1 and 11, and column 6, lines 40 through 47), which comprises a step of inputting a manual designation caused by an operator (mail terminal 161, and column 3, line 66 through column 4, line 34), a step of transmitting data based on a designation input in the input step (column 4, lines 48 through 62), and a step of notifying information related to data communication performed in the transmission

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step based on the designation input in the input step to the data processing terminal in accordance with a change in state of the data communication system (column 4, lines 35 through 47).

Regarding **claim 19**, Okumura discloses a computer readable program (column 3, lines 56 through 68) stored in a storage medium for controlling a data communication system connected to a data processing terminal (PBX 140 connected to mail terminal 161 in Figs. 1 and 11, and column 6, lines 40 through 47), which comprises a step of inputting a manual designation caused by an operator (mail terminal 161, and column 3, line 66 through column 4, line 34), a step of designating an ID (column 3, line 68 through column 4, line 2, and lines 50 through 62, and column 7, lines 9 through 22), a step of transmitting data based on a designation input in the input step (column 4, lines 48 through 62), and a step of notifying information related to data communication performed in the transmission step based on the designation input in the input step to the data processing terminal in accordance with the ID in the designation step (column 4, lines 35 through 47).

12. **Claims 1 through 4, and 6 through 20** are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto *et al.* (U.S. Patent Number 5,644,404).

Regarding **claim 1**, Hashimoto discloses a data communication system (terminal 3, column 4, lines 56 through 58) which comprises a means connected to a data processing terminal (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56), a means for inputting a manual designation caused by an operator (keyboard 12b, and column 5, lines 1

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through 8, and column 15, lines 8 through 22), a means for transmitting data on the basis of the designation input by the operation means (column 17, lines 40 through 65), and a means for notifying information related to data transmission performed by the transmission means based on the designation input by the operation means to the data processing terminal through the connection means in accordance with a change in state of the data communication system (see Fig. 23, and column 15, lines 8 through 22).

Regarding **claim 2**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the transmission means transmitting data on the basis of a second designation from the data processing terminal connected through the connection means (column 7, line 30 through column 8, line 45, and column 8, line 54 through column 9, line 15).

Regarding **claim 3**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the information notified by the notification means includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 4**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means performing notification in accordance with a change in information to be notified (column 15, lines 12 through 22).

Regarding **claim 6**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 15, lines 20 through 22, type of data 2303).

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Regarding **claim 7**, Hashimoto discloses a data communication system (terminal 3, column 4, lines 56 through 58) which comprises a means connected to a data processing terminal (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56), a means for inputting a manual designation caused by an operator (keyboard 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a means for designating an ID by an operation of the operation means (Figs. 23 and 24B, and column 17, lines 17 through 35), a means for transmitting data on the basis of the designation input by the operation means (column 17, lines 40 through 65), and a means for notifying information related to data transmission performed by the transmission means based on the designation input by the operation means to the data processing terminal through the connection means in accordance with the ID designation performed by the designation means (see Fig. 23, and column 15, lines 8 through 22).

Regarding **claim 8**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the notification means not performing notification in an absence of an ID designated by the designation means (column 7, lines 46 through 67, and column 8, lines 15 through 32).

Regarding **claim 9**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the ID designated by the designation means is information representing a user on a network (column 15, lines 37 through 42).

Regarding **claim 10**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the transmission means transmitting data on the basis of a

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second designation from the data processing terminal connected through the connection means (column 7, line 30 through column 8, line 45, and column 8, line 54 through column 9, line 15).

Regarding **claim 11**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the information notified by the notification means includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 12**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 15, lines 20 through 22, type of data 2303).

Regarding **claim 13**, Hashimoto discloses a method of controlling a data processing terminal (facsimile server terminal 1, column 4, lines 52 through 56), connected to a data communication system (terminal 3, column 4, lines 56 through 58) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63). Hashimoto's method for controlling the data communication system comprises a step of receiving information related to data communication performed by a manual operation performed by the data communication system (column 15, lines 8 through 22, and column 9, lines 39 through 45), a step of designating data communication to the data communication system (column 5, line 29 through column 6, line 15, column 7, line 30 through column 8, line 45, and column 17, lines 17 through 65), and a step of independently storing the information received in the reception step and information related to data communication based on the designation in the designation step (column 6, lines 34 through 49, and column 8, lines 35 through 45).

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Regarding **claim 14**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the information representing a user ID is received in the reception step (column 5, lines 41 through 48), and information related to data communication is stored in an area corresponding to the user ID in the storage step (column 8, lines 35 through 45).

Regarding **claim 15**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the data received by the data communication system (client terminal 3) is received in the reception step (column 8, line 54 through column 9, line 15, and column 17, lines 17 through 34).

Regarding **claim 16**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the information received in the reception step includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 17**, Hashimoto discloses a method of controlling a system having a data communication system (terminal 3, column 4, lines 56 through 58) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63) and a data processing terminal (facsimile server terminal 1, column 4, lines 52 through 56) for controlling the data communication system. Hashimoto's method at the data communication system (terminal 3, column 4, lines 56 through 58) comprises the step of designating an ID on the basis of a manual operation of the data communication system and performing data communication (through keyboard 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), and a step of notifying information related to the data communication to a data terminal (see Fig. 23, and

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column 15, lines 8 through 22). Hashimoto's method at the data processing terminal (facsimile server terminal 1, column 4, lines 52 through 56) comprises the step of designating data communication to the data communication system (column 5, line 29 through column 6, line 15), a step of receiving information notified by the data communication system (column 5, lines 9 through 48, and column 15, lines 8 through 42), and a step of independently storing information related to data communication based on the designation and the information received from the data communication system (column 6, lines 34 through 49, and column 8, lines 35 through 45).

Regarding **claim 18**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (terminal 3, column 4, lines 56 through 58) connected to a data processing terminal (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56), which comprises a step of inputting a manual designation caused by an operator (through keyboard 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a step of transmitting data based on a designation input in the input step (column 17, lines 40 through 65), and a step of notifying information related to data communication performed in the transmission step based on the designation input in the input step to the data processing terminal in accordance with a change in state of the data communication system (see Fig. 23, and column 15, lines 8 through 22).

Regarding **claim 19**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (terminal 3, column 4, lines 56 through 58) connected to a data processing terminal (LAN 4

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connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56), which comprises a step of inputting a manual designation caused by an operator (through keyboard 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a step of designating an ID (Figs. 23 and 24B, and column 17, lines 17 through 35), a step of transmitting data based on a designation input in the input step (column 17, lines 40 through 65), and a step of notifying information related to data communication performed in the transmission step based on the designation input in the input step to the data processing terminal in accordance with the ID in the designation step (see Fig. 23, and column 15, lines 8 through 22).

Regarding **claim 20**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data processing terminal (facsimile server terminal 1, column 4, lines 52 through 56), connected to a data communication system (terminal 3, column 4, lines 56 through 58) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63). Hashimoto's program for controlling the data communication system comprises a step of receiving information related to data communication performed by a manual operation performed by the data communication system (column 15, lines 8 through 22), a step of designating data communication to the data communication system (column 17, lines 17 through 65), and a step of independently storing the information received in the reception step and information related to data communication based on the designation in the designation step (column 6, lines 34 through 49, and column 8, lines 35 through 45).

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Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Lam (U.S. Patent Number 5,377,017).

Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying information related to the data transmission, but fails to specifically disclose of notifying information related to data transmission upon completion of the data transmission performed by the transmission means. It is well known within the art to send an "end of message" (EOM 505, in Fig. 5) signal in a facsimile system upon completion of the data transmission, as shown by Lam, to inform the destination of no further pages. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate an "end of message" signal within Hashimoto's notifying information, thereby having notifying information upon completion of the data transmission. The "end of message" signal of Lam is a well known practice in the art, and could easily have been included in Hashimoto's system.

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Citation of Pertinent Prior Art

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Baek *et al.* (U.S. Patent Number 5,798,845) discloses a method of a facsimile system wherein an ID of a terminal is registered, and can be added to the transmission of data;

Maemura (U.S. Patent Number 5,633,731) discloses a facsimile apparatus which communicates with a terminal by transmitting or receiving the image data and file identification values.

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Conclusion


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

March 5, 1999


EDWARD L. COLES
SUPERVISORY PATENT EXAMINER
GROUP 2700